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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/697,428      | 10/26/2000  | Bruce A Beadle       | AUS9200000120US1    | 4820             |

7590 07/28/2005

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EXAMINER

THOMPSON, MARC D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2144

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/697,428

Applicant(s)

BEADLE, BRUCE A

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-5, 10-13 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10-13 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendment, received 4/15/2005, has been entered into record.
2. Claims 2-5, 10-13, and 18-21 remain pending.

#### ***Priority***

3. No claim for priority has been made in this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 10/26/2000.

#### ***Drawings***

5. The Examiner contends that the drawings submitted on 10/25/2000 are acceptable for examination proceedings.

#### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, the claimed invention lacks patentable utility, and the disclosed invention is inoperative and therefore lacks utility.

8. Claims 18-21 describe a "computer program product..." comprising segments of programmatic code. This type of claim does not meet statutory requirements as set forth in the MPEP § 2106. These claims do not require any interaction with associated hardware or functional state change of associated hardware components required for statutory compliance. Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data (e.g., code segments), are merely stored so as to be

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read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. See MPEP § 2106(IV)(B)(1)(B). The storage of computer programmatic functionality on a computer readable medium, itself, does not constitute patentable subject matter. No imparted functionality between the medium and the computer has been recited or identified, nor any interrelationship between the claimed computer program and any functional activity of the computer has been recited, resulting in completely non-functional material. In short, the invention as set forth in claims 18-21 does not DO anything, and exemplifies non-statutory subject matter.

These are examples of acceptable claim wording for computer software products:

A computer program product on a computer readable medium, which when executed by a computer causes the computer to...,

said computer program product comprising,

means for ...,  
means for ...,  
means for....

-and-

A computer readable medium storing thereon a computer program for...,

said computer program, when executed by a computer, causes the computer to perform the steps of:

a step for...  
a step for...  
a step for....

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9. Also see MPEP § 2106 regarding computer related inventions, where detailed that “software” is generally not patentable as such, but must be claimed as process steps, or as a machine, or as manufacture. For example, software may be claimed as machine or [article of] manufacture by stating “a computer readable media containing instructions, which when executed, cause the following steps to be performed”.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claims 2-5, 10-13, and 18-21 are rejected under 35 U.S.C. §102(e) as being anticipated by Bates et al. (U.S. Patent Number 6,832,350), hereinafter referred to as Bates ‘350.

12. Bates ‘350 disclosed organization and effective categorization of bookmarks (i.e., hotlist of pages) using keywords in the document and associated description(s). See, inter alia, Abstract. All the functionality was described as preferably implemented in a browser client application. See, inter alia, Column 7, Lines 33-39, and Column 9, Lines 18-20 and 31-41. The system determined “affinity” between bookmarked documents based on keywords from the document. See, inter alia, Column 2, Lines 65 through Column 3, Line 20. The system described both the use of HTML metadata tag information (inter alia, Column 3, Lines 20-23) and without use of metadata (inter alia, Column 3, Lines 29-31, and Column 11, Lines 31-34).

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The addition of a bookmark to the list by a user was evident, inter alia, in Column 9, Lines 42-44. The subsequent processing to create an entry representing the page (and associated affinity/other information) directly followed. See, inter alia, Column 9, Lines 44-46, and Figure 4. This determined information was described as directly associated with the bookmarked pages in the list itself, or external to the list. See, inter alia, Column 10, Lines 37-45.

13. In short, Bates '350 disclosed the provision for a client application browser providing user specification of bookmark identification, processing of these bookmarks to search, extract, and store keywords associated with the documents referenced by the bookmarks, optionally without already embedded metadata. The keyword information was stored in association with the bookmark entr(ies). Further provision for user editing of the entries was evident, inter alia, in Column 13, Lines 47-55, searching (filtering) the bookmark entries for matching information (inter alia, Columns 15-16), and retrieval and display of requested pages referenced by browser bookmarks were disclosed as known in the art (Column 7, Lines 5-11).

14. Since the entirety of the invention as claimed was disclosed by Bates '350, claims 2-5, 10-13, and 18-21 are rejected.

15. Claims 2-5, 10-13, and 18-21 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Douglass et al. (U.S. Patent Application Publication Number US 2002/0040311), hereinafter referred to as Douglass.

16. Douglass disclosed the automatic extraction of keywords/metadata from visited/bookmarked webpages, and user modification of these descriptive keyword(s). See, inter alia, Figure 1, and Page 2, Paragraphs [0020] through [0028]. Clearly, keyword fields were

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defined to designate particular keywords for the page(s) in the "Keyword Library" and storage of relevancy ratings. See, inter alia, step (26) and (40). The automatic generation of keywords for document(s) was disclosed as performed, inter alia, in step (30). Since, Douglass disclosed the processing of navigation history (not user designated) and/or bookmarks (necessarily user designated) to effect keyword generation and ratings for webpages in Paragraph [0024] and Figure 6, the provision for keyword generation to documents specified by the user to be of interest was clearly disclosed.

17. Claims 2-5, 10-13, and 18-21 are rejected.

#### *Response to Arguments*

18. The arguments presented by Applicant in the response, received on 12/7/2004, are not considered persuasive.

19. Applicant argues the prior art does not disclose "a browser client creating an entry representing a page [] in response to a user designating a page as a page of interest by requesting said entry". See, inter alia, Response, received 12/7/2004, Page 9. It is noted that the provision for a user/client to specify indication of a bookmark was both well known in the art at time of the invention, and was disclosed by Bates '350, inter alia, in Column 1, Lines 59-67, and minimally, process (184). In view of the state of the art at the time of filing, the argument of this feature as patentable is simply inane. Any processing of bookmarked pages, through the use of referenced use to designate these particular documents, is independent from how the bookmarks were gathered. The provision for a user to select a particular bookmark for processing, and the automatic processing of every accessed document through the use of referencing bookmarks,

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does not constitute a patentable difference, simply because (1) the automatic processing of every page and the automation of a manual activity (should the user select each and every page visited), and (2) the omission of undesired elements (i.e., the processing of pages not of interest to a user) are obvious variations of established well known subject matter. See MPEP §2144.04)

20. Applicant asserts since “Applicant is unable to ascertain whether the content of [Douglass provisional application to which priority is claimed] supports any disclosure that Examiner alleges to be present in Douglass”, that “Douglass is ineligible as prior art.” See, Response, received 12/7/2004, Page 10. First, validity of the patent and associated priority claim is presumed. See 35 U.S.C § 282. Second, the statement that “Douglass is ineligible as prior art” is completely baseless, since the disclosure of Douglass which has support in the filed provisional application is intrinsically prior art. Examiner submits that the entirety of the Douglass patent has support evident in the provisional application, included herewith.

21. Applicant asserts the prior art, Douglass in particular, did not teach keyword searching or generating [] as responsive to user selection. See, Response, received 12/7/2004, Page 11. As written above, Douglass disclosed the processing of navigation history (not user designated) and/or bookmarks (necessarily user designated) to effect keyword generation and ratings for webpages in Paragraph [0024] and Figure 6. Thus, the provision for keyword generation to documents specified by the user to be of interest was clearly disclosed. After all, bookmarks must be presumed to be designated solely by the client user, since the distinct designation of a navigation history was made by Douglass.

22. Applicant also asserts the prior art as applied (again, Douglass) did not teach keyword and metadata generation, responsive to missing metadata. See, Response received 12/7/2004,



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Pages 11-12. It is submitted that the partial, incomplete, and non-exhaustive list of elements used to rate web pages evident in Paragraphs [0027]-[0032] provided a set of tools for ranking documents, and minimally, Paragraph [0034] stating, "...some features of the present invention may be employed without a corresponding use of the other features...", the provision for ranking without the use or necessity of metadata is well within the scope of the Douglass teachings. In fact, Examiner asserts that the system was disclosed as fully capable of ranking documents with or without any preliminary indication(s) of metadata for the documents. In order to rank document(s) without associated metadata, metadata would have been generated; this is the pure functioning of Douglass. Thus, the system required the generation of sufficient information to properly rank the page(s); if metadata information was not present, other method(s) of ranking and keyword generation occurred. Thus, this piece of prior art, minimally, fully disclosed the selective designation of bookmarks by a user, and the generation of keyword information for page ranking made in response to not yet present metadata.

### ***Conclusion***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached at 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned has recently changed, and is now 571-273-8300.

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24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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